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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of

Magnus N. NILSSON et al

Serial No.: 09/964,~~838~~ 839

Filed: September 28, 2001

Group Art Unit: 1732

Examiner: M. Fontaine

For: A PROCESS FOR THE MANUFACTURE OF SURFACE ELEMENTS

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Responsive to the Office Action mailed January 25, 2005, reconsideration of the rejections set forth therein are respectfully requested in view of the following comments.

Reconsideration of claim 1 as being unpatentable under 35 U.S.C. §103(a) over Scher et al (U.S. Patent 4,092,198), in view of Schmoock (U.S. Patent 5,344,692) is respectfully requested.

The Examiner alleges that "Scher shows that it is known to carry out a method for the manufacture of a decorative surface element." However, the Examiner concedes that "Scher does not show using a UV-curable resin in his decorative surface element."

The Examiner relies on Schmoock for the allegation that "Schmoock shows that it is known to carry out a method for making a decorative surface element using a layer of UV-curing lacquer (citing column 4, lines 11-13)." The Examiner continues that Schmoock and Scher are combinable because they are concerned with a similar technical field, mainly that of methods and making decorative surface elements that have structured surfaces.

For the following reasons, applicants respectfully request reconsideration of this rejection based on those statements alleged in the Office Action.

Initially, applicants note that Schmoock relates to a flexible laminate comprising a low-grade or damaged leather substrate which comprises a non-crosslinked thermoplastic which is flowable in response to heating (See, for example, Claim 1). Although the Examiner specifically mentions column 4, lines 11-13 of Schmoock, there it is only mentioned that it is impossible to employ an inner-layer which consists of or contains a lacquer and is hardened as a result of exposure to ultra-violet (UV) radiation. The Examiner states that the above two references (i.e., Scher and Schmoock) are combinable because they are concerned with a similar technical field, namely that of method of making decorative surface elements that have structured surfaces.

Applicants strongly object to the combination of the two references for the reasons set forth in the Office Action. These references are not directed to a similar or same technical field and, indeed, Schmoock relates to a totally different technical field, namely a flexible laminate comprising a low-grade or damaged leather, where the unevenness of one side of the substrate is coated with a thermoplastic material, which is flowable at 110°-130° (See, claim 1). Moreover, the Examiner alleges that Scher teaches "a base layer, a decor layer of lacquer and a wear layer (citing the Abstract), page 2, lines 13-14. However, in the claimed invention, the lacquer is the wear layer.

Unlike the invention claimed in independent claim 1, there is no wear layer of a UV or electron beam curing lacquer on top of the leather laminate of Schmoock. Instead, column 4, lines 11-13 relied upon by the examiner mentions that an inner layer, which consists of or contains a lacquer is hardened as a result of exposure to ultra-violet radiation may be used. Thus, it is clear that it is not a top layer (wear-layer) in Schmoock but, rather, Schmoock only concerns a leather product containing a thermoplastic material which has nothing in common with the present decorative surface element with

a specific thermosetting wear layer on top, i.e., a UV or electron beam curing lacquer. Applicants respectfully submit that it is improper for the Examiner to disregard the teachings of Schmoock concerning low-grade leather combined with a thermoplastic material and merely pick out two isolated lines in column 4 as being of the same type of surface or product as being produced by Scher. In any event, the teachings of Schmoock at column 4, lines 11-13, do not refer to a wear layer (on top), but, rather, an inner layer as mentioned above. Thus, the combination of Scher and Schmoock would still not teach nor make obvious the invention as claimed in independent claim 1.

For the foregoing reasons, withdrawal of the rejection is respectfully requested.

Claims 26-30 and 39 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Scher and Schmoock, further in view of McQueen et al (U.S. Patent 6,399,670).

This rejection is clearly improper insofar as it is necessary to combine references to make the proposed anticipatory rejection.

It is a matter of commonly accepted fact that in order to be an anticipatory reference (a §102 reference), a single reference must teach all the elements of the claimed invention (See, for example, MPEP §706.02IV). For the foregoing reasons, the rejection of claims 26-30 and 39 under 35 U.S.C. §102(e) as being unpatentable over Scher and Schmoock, further in view of McQueen et al is untenable and must be withdrawn.

Reconsideration of the previous rejection of claims 32, 40-41, 43 and 51-52 under 35 U.S.C. §103(a) as being unpatentable over Scher is respectfully requested.

This rejection is also untenable. As the claims depend (directly or indirectly) from claim 1, it is not possible for the examiner to reject the dependent claims over Scher alone when the independent

claim must be rejected over the combination of Scher in view of Schmoock. For the foregoing reasons, this rejection is untenable and withdrawal thereof is respectfully requested. Notwithstanding the foregoing arguments, applicants respectfully submit that as the dependent claims include all the limitations of independent claim 1, they are allowable for the reasons set forth above with regard to the combination of Scher and Schmook in the rejection of claim 1. More specifically, the dependent claims present additional limitations not taught by Scher alone. For example, with regard to claim 32, the Examiner concedes that Scher "does not specifically use glazing rollers." However, there is no additional reference to show why it would have been obvious to one of ordinary skill in the art at the time the invention was made to use glazing rollers as instantly claimed. For the foregoing reasons, withdrawal of the rejection of claim 32 is respectfully requested.

With regard to the rejection of claim 41, applicants note that claim 41 is dependent on claim 39, which is not rejected over Scher alone or Scher in combination with Schmoock. Thus, claim 41 cannot be rejected over Scher alone as instantly set forth. With regard to claim 40, applicants note that claim 40 is dependent on claim 32, which recites the process of the glazing roller. As with the deficiencies of Scher as to claim 32, the Examiner also concedes with regard to claim 40 that "he [Scher] does not specifically use glazing rollers . . . ." Accordingly, in the absence of any secondary reference showing the use of glazing rollers, the Examiner has not established a *prima facie* case of obviousness that would have motivated one skilled in the art to modify the teachings of Scher as proposed in the rejection.

As Scher does not teach the use of glazing rollers, it would not have been obvious to have the spacing distance between glazing roller and a corresponding counterstay, as set forth specifically in

the limitations of claim 43. Furthermore, as claims 51-52 further specify the distance between a structured roller and a corresponding counter stay, the Examiner has not provided any teaching for the ranges recited therein so as to establish a *prima facie* case of obviousness for the claimed invention. Accordingly, withdrawal of all rejections of claims 32, 40-41, 43 and 51-52 as being unpatentable under §103(a) over Scher alone are respectfully requested.

Claims 33-34, 45, 50 and 56-68 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Scher (discussed above) in view of Petry (U.S. Patent 3,196,030). Reconsideration of this rejection is respectfully requested.

It is noted that claims 33-34, 45, 50 and 56-58 are directly or indirectly dependent upon claim 1 and, thus, include all the limitations of claim 1. As the Examiner has not rejected claim 1 over Scher alone, it is impossible to sustain a rejection against these dependent claims on the combination of Scher in view of Petry where claim 1 from which they depend is not rejected over the proposed combination of Scher and Petry.

Notwithstanding the above, it is further noted that although claim 34 specifically recites the surface temperature of the glazing rolls, applicants remind the Examiner of his previous concessions with regard to claim 1 that "Scher does not show using a UV-curable resin in his decorative surface element" as well as claim 32 that "he [Scher] does not specifically use glazing rolls" and, thus, these limitations, incorporated by reference into each of the dependent claims (35 U.S.C. §112, 4th paragraph), is not met by the proposed combination of Scher and Petry. Accordingly, withdrawal of the rejection is respectfully requested.

Reconsideration of the previous rejection of claims 35-38 under 35 U.S.C. §103(a) as being unpatentable over Scher in view of Eby et al (U.S. Patent 5,961,903) is respectfully requested.

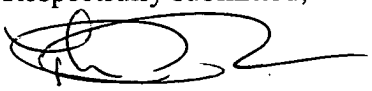
Like the other rejection, claim 35 is directly dependent on claim 1 and the other claims are indirectly dependent on claim 1. Accordingly, the limitations of claim 1 are present, directly or indirectly, in each of these dependent claims. Because the combination of Scher with Eby does not cure the deficiency acknowledged by the Examiner in Scher, i.e., the failure of "Scher does not show using a UV-curable resin in his decorative surface element," the proposed combination of Scher and Eby cannot possibly establish a *prima facie* case of obviousness for claims 35-38. Accordingly, withdrawal of the rejection is respectfully requested.

Similar reconsideration of the other rejections over Scher in view of Nishimura et al (U.S. Patent 4,216,251) (as applied to claim 31 alone) or Scher in view of Schmidt et al (U.S. Patent 5,804,116) (applied to claims 42 and 43) or the rejection of claims 46 and 55 over the combination of Scher and Petry, further in view of Schmidt or, alternatively, the rejection of claims 47-49 as unpatentable over Scher in view of James et al (U.S. Patent 6,354,915) is respectfully requested.

As in the other rejections, Scher is acknowledged by the Examiner to have a deficiency in that "Scher does not show using a UV-curable resin in his decorative surface element." Moreover, there is not even the allegation that any reference teaches a UV-curable lacquer ear layer. Accordingly, as each of these dependent claims includes all the limitations of claim 1 from which they directly or indirectly depend, the citation of Scher in combination one or more of the secondary references still does cure the foregoing deficiency of Scher and, therefore, cannot establish a *prima facie* case of

obviousness for the claimed invention. Accordingly, withdrawal of all rejections and passage of the application to issue are respectfully requested.

Respectfully submitted,



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